

REMARKS

The Applicant incorporates the arguments of its previous response of August 29, 2005, and further provides additional arguments in opposition to the Office's improper rejections of Claims 1-8.

Rejections over Grady and Tjaden

The Office improperly rejected Claims 1-4, 7-8 as being unpatentable over Grady in view of Tjaden

The Office improperly relies on Tjaden to provide the steps of:

- (e) assigning a unique access number ("PIN") to each candidate in the target group;
- (f) electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the website;
- (g) providing each candidate accessing the web site and indicating a continuing interest in the educational institution with electronic access to a partial application:
- (h) for each candidate who electronically accesses a partial application, customizing the partial application with personal information from the database;
- (i) compiling the partial applications which have been electronically completed; and
- (j) transmitting the partial applications to the educational institution.

The Office improperly contends that these features are implied.

"These implications also have the functional limitations of [e] assigning a unique access number ("PIN") to each candidate

in the target group; [f] electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the web site; [g] providing each candidate accessing the web site and indicating a continuing interest in the education institution with electronic access to partial application; [h] for each candidate who electronically accesses a partial application, customizing the partial application with personal information from the database; [i] compiling the partial application which have been electronically completed; and [j] transmitting the partial application to the educational institution". (Office Action of November 17, 2005, Pg. 5) (identifiers [e-j] added)

The Applicant has searched the cited references extensively and has found no basis for the Office's assertions. Not only does Tjaden not imply the steps recited by the Office, but when have implications become a sound basis for a disclosure. The Office is respectively reminded that all of the elements must be shown in a reference or combination of references. Again, as noted in Applicant's previous response, the Office is attempting a back door to inherency. It is well settled that to rely on inherency, the feature must be necessarily present, not possibly present or even likely present, but necessarily present. The Office's implications clearly fail the inherency test.

1. Tjaden does not disclose, teach or suggest (e) providing a unique access number to a candidate, rather Tjaden discloses assigning an identification code for an institution participating in Tjaden's proposed survey. Tjaden recites:

"An identification code will be provided to each participating school in order to correlate data by institution." Tjaden, Pg. 31

How the Office can contort this passage to disclosing or even implying assigning a

unique access code, is beyond the comprehension of the Applicant.

2. Tjaden does not disclose or imply (f) electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the web site. Tjaden provides Web based tools to the institution and allows the forms to be downloaded by the institutions. There is no disclosure or implication that an access number, form or anything else is electronically mailed to the candidates in the target group. Tjaden recites:

“The tools provided by the World Wide Web will include web-based forms for effortless data entry. Optionally, the forms may be downloaded by the participating schools for manual data entry by those who so choose” Tjaden, Pg. 31

and

“The survey instrument will be one that can be administered to the subjects by the classroom instructor prior to the end of the course.” Tjaden, Pg. 31

These portions and indeed the entirety of Tjaden, despite the Office’s musings, clearly do not disclose providing electronically an assigned PIN and an invitation to the subject (candidates) to access the website.

3. Tjaden also does not disclose, suggest, teach, imply, hint or even contemplate(g) providing each candidate accessing the web site and indicating a continuing interest in the education institution with electronic access to a partial application. A mere reading of Tjaden’s title “A Worldwide, Web-Based Study of the Attitudes of College Freshmen toward Computing” should disavow any thought to the

contrary. Why would institutions provide access to applications, much less a partial application to their own already enrolled students? Nowhere in Tjaden is a discussion of evaluating the continued interest in the educational institutions, much less providing anything to the candidate based on such continued interest.

4. Not surprisingly, Tjaden also does not disclose (h) customizing, (i) compiling or (j) transmitting the partial application to the institution. The survey instrument of Tjaden is not an application. Tjaden simply does not teach what the Office purports it to teach and therefore fails to provide the teachings that the Office has admitted are not shown in Grady ¹(see page 3, Office Action of November 17, 2005).

Therefore the Office must withdraw the rejection of Independent Claim 1 and likewise Claim 7 as the Office has “rejected [them] under the same rationale”. The rejection of Claims 2- 4 and 8 should likewise be withdrawn, since they depend from Claims 1 and 7 respectively, without recourse to additional patentable features recited therein.

¹ “Grady fails to specifically provide each target candidate with an access number to ensure that each candidate to access his/her own personal information and wherein only one survey response or application is submitted by an individual candidate and also access to a partial application to the educational institution for enrollment” page 3

Rejections over Grady, Tjaden and Sharma

The Office also improperly rejected Claims 5-6 as being unpatentable over Grady et al., Tjaden and further in view of Sharma.

Claims 5 and 6 depend from Independent Claim 1. Sharma is used by the Office in an attempt to provide a teaching of providing an incentive in return for submitting a complete application. Sharma does nothing to obviate the deficiencies of Grady and Tjaden discussed above which in itself is fatal to the rejection. The Applicant requests withdrawal of the rejection.

Office's Mischaracterizations

Several other recitations in the Office Action cannot stand and some are thus addressed by the Applicant, further negating the Office's rejections.

The Office incorrectly states on page 3

"It is important to note that Grady discloses a system that sends registrant (candidate) specified school information including GMAT scores, his/her undergraduate academic record and the registrant's (candidate's) background characteristics (age, sex, and race), wherein this information is useful to a recipient school in accessing the attributes of its applicants"

The Office is mistaken. Grady discloses a system that sends the school not the registrant specified school information.

The Office also improperly infers on page 4

"These implications have the functional limitations of allowing the candidate to have accessed to a partial

application for enrollment”.

The Office’s logic is seriously flawed. Grady is silent on how the application was accessed. The claims clearly states providing each candidate ...with electronic access to a partial application. The Office’s improper implication that a partial application must have been electronically accessed since some of the candidates knew of their acceptance or denial is ridiculous. Possessing knowledge of admittance in no manner discloses electronic access to the application, much less a partial application. Additionally, the present claims are directed to a method generating applications, an application from someone who already has been accepted or denied is incongruent.

CONCLUSION

The Office’s application of Grady and Tjaden does not result in establishing a prima facie case of obviousness, since several elements are not taught in the combination. Furthermore, Sharma does nothing to obviate these deficiencies and also does not teach what the Office purports it to disclose.

The Applicant request allowance of the Application including Claims 1-8. If the Office is of the opinion that the application is still not in condition for allowance, he is urged to contact the undersigned attorney.

Respectfully submitted,



Mark C. Comtois	Reg. No. 46, 285
D. Joseph English	Reg. No. 42,514
Patrick D. McPherson	Reg. No. 46,255

DUANE MORRIS LLP
1667 K Street, N.W., Suite 700
Washington, D.C. 20005
Telephone: (202) 776-7800
Telecopier: (202) 776-7801

Date: January 24, 2006